

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN E. ROBBINS

Appeal No. 2001-0378
Application No. 08/873,876

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 18, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a resilient sole having a controlled stiffness and slow shape recovery following

compressive deformation to provide enhanced stability (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Pendergast 4,633,877 Jan. 6, 1987

Claims 1 to 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 to 18 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 to 3, 7 to 11 and 15 to 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pendergast.

Claims 4 to 6 and 12 to 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pendergast.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 28, mailed June 23, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 27, filed May 19, 2000) and reply brief (Paper No. 29, filed August 28, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, to the declaration under 37 CFR § 1.132 by Steven Robbins (Paper No. 26, filed May 19, 2000) and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 18 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be

patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, we turn to the specific reason set forth by the examiner as the basis for the rejection under 35 U.S.C. § 112, second paragraph. The examiner stated (answer, p. 4) that the phrase "resiliency index ..." as used in the claims under appeal is vague and indefinite because "it is not clear what materials applicant intends to encompass with such language. We do not agree for the reasons set forth in the brief, the reply brief, and the reasons that follow.

The independent claims on appeal read as follows:

1. A sole for use in an article of footwear in proximity to a plantar surface of a foot, said sole having a resiliency index in the range from about .05 to about .5, the resiliency index being defined as a ratio $(R-M)/(P-M)$, wherein P is a thickness measured when only a pre-load is applied, M is a thickness measured when both the pre-load and a main load are applied, and R is the maximum recovered thickness within one second immediately following removal of the main load.

9. An article of footwear including a sole in proximity of afoot receiving surface of said article of footwear, said sole having a resiliency index in the range from about .05 to about .5, the resiliency index being defined as a ratio $(R-M)/(P-M)$, wherein P is a thickness measured when only a pre-load is applied, M is a thickness measured when both the pre-load and a main load are applied, and R is the maximum

recovered thickness within one second immediately following removal of the main load.

In our view, the phrase "resiliency index . . ." as used in the claims under appeal is not vague and indefinite because the metes and bounds of the claimed invention is defined with a reasonable degree of precision and particularity. It is clear to us that the appellant intends to encompass all materials having the claimed resiliency index with such language. In that regard, it is well-settled that the mere breadth of a claim does not in and of itself make a claim indefinite.¹

For the reasons set forth above, the decision of the examiner to reject claims 1 to 18 under 35 U.S.C. § 112, second paragraph, is reversed.

The enablement rejection

We will not sustain the rejection of claims 1 to 18 under 35 U.S.C. § 112, first paragraph.

¹ Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telecommunications, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a nonenablement rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in

describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Once the examiner has established a reasonable basis to question the enablement provided for the claimed invention, the burden falls on the appellant to present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide. See In re Brandstadter, 484 F.2d 1395, 1406, 179 USPQ 286, 294 (CCPA 1973). In making the

determination of enablement, the examiner shall consider the original disclosure and all evidence in the record, weighing evidence that supports enablement² against evidence that the specification is not enabling.

Thus, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. The threshold step in resolving this issue as set forth *supra* is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done. In fact, the examiner has not provided any cogent reasoning as to why the appellant's disclosure would not have enabled a person of ordinary skill to make and use the claimed invention without undue experimentation. Instead, the examiner (answer, p. 3) questions how the claimed range of the resiliency

² The appellant may attempt to overcome the examiner's doubt about enablement by pointing to details in the disclosure but may not add new matter. The appellant may also submit factual affidavits under 37 CFR § 1.132 or cite references to show what one skilled in the art would have known at the time of filing the application.

index was determined and that only a single example of a suitable material was provided.

In our opinion the examiner has not met his burden of proof by advancing acceptable reasoning inconsistent with enablement for the following reasons.

Factors to be considered in determining whether a disclosure would require undue experimentation include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. See In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) citing Ex parte Forman, 230 USPQ 546, 547 (Bd. Pat. App. & Int. 1986).

In this case, the examiner has focused only on one of the above-noted eight factors (i.e., working examples) as the basis that led the examiner to conclude that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. Since the

examiner has not weighed all the factors, the examiner's conclusion of nonenablement cannot be sustained. As stated in the Manual of Patent Examining Procedure (MPEP) § 2164.02 (Seventh Edition, Rev. 1, Feb. 2000)

When considering the factors relating to a determination of non-enablement, if all the other factors point toward enablement, then the absence of working examples will not by itself render the invention non-enabled. In other words, lack of working examples or lack of evidence that the claimed invention works as described should never be the sole reason for rejecting the claimed invention on the grounds of lack of enablement.

The presence of only one working example should never be the sole reason for rejecting claims as being broader than the enabling disclosure, even though it is a factor to be considered along with all the other factors. To make a valid rejection, one must evaluate all the facts and evidence and state why one would not expect to be able to extrapolate that one example across the entire scope of the claims.

Furthermore, when all the factors are considered, it is our view that it would not require undue experimentation to practice the invention as set forth in the claims under appeal. In that regard, we note that in addition to the one example provided by the appellant, the appellant also provides guidance in the specification to select a material for the sole having a resiliency index in the range from about .05 to about .5. This

teaching would direct an artisan practicing the claimed invention to choose any material having the claimed resiliency index. Moreover, the quantity of experimentation necessary to test a material to determine its resiliency index appears to be small since all that would be necessary is to test the material as set forth in the appellant's discussion of Figure 3.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 18 under 35 U.S.C. § 112, first paragraph, is reversed.

The anticipation rejection

We will not sustain the rejection of claims 1 to 3, 7 to 11 and 15 to 18 under 35 U.S.C. § 102(b).

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirg v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). However, inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art. See Mehl/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999).

The position of the examiner as set forth in the anticipation rejection before us in this appeal (answer, p. 4) is that the sole of Pendergast made from PVC foam with a Shore

A hardness of from 5A to 50A inherently would have a resiliency index in the range from about .05 to about .5.

We find the examiner's position to be without merit. As set forth above, inherency may not be established by probabilities or possibilities. In our view, Pendergast's teachings of a sole made from PVC foam with a Shore A hardness of from 5A to 50A would not inherently have a resiliency index in the range from about .05 to about .5 for the reasons set forth in Steven Robbins' declaration under 37 CFR § 1.132. The mere fact that one particular PVC foam (i.e., the PVC aerated polymer foam of Shore A5 hardness identified on page 14 of the specification) has a resiliency index in the range from about .05 to about .5 is not a sufficient basis to conclude that Pendergast's sole made from PVC foam with a Shore A hardness of from 5A to 50A would inherently have a resiliency index in the range from about .05 to about .5.

Since all the limitations of claims 1 to 3, 7 to 11 and 15 to 18 are not disclosed in Pendergast for the reasons set forth above, the decision of the examiner to reject claims 1 to 3, 7 to 11 and 15 to 18 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of dependent claims 4 to 6 and 12 to 14 under 35 U.S.C. § 103 for the reasons set forth above with respect to their parent claims. In that regard, we note that in the rejection under 35 U.S.C. § 103 before us in this appeal the examiner has not found the difference identified above between Pendergast and claims 1 and 9 to have been obvious at the time the invention was made to a person of ordinary skill in the art.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 18 is reversed.

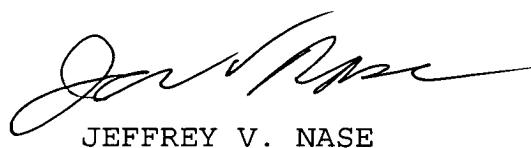
REVERSED


IRWIN CHARLES COHEN
Administrative Patent Judge

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